

REMARKS

Claims 1, 3-4, 6-7, 9-10, 12-13, 15-16, 18-22, 25, 27-33, 36-45, 50, 53-56, and 59-70 are pending in this application. In the last Office Action, the Examiner rejected claims 1-4, 6-10, 12-16, 18-22, 25-28, 30-33, and 36-69 under 35 U.S.C. § 102(e) as being anticipated by Kikinis, U.S. Patent no. 5,727,159 ("Kikinis"). Claim 70 was rejected under 35 U.S.C. § 103(a) as being obvious over Kikinis.

By this amendment, Applicants propose to amend claims 1, 7, 13, 25, 36, 41, 50, 56 and 66. Support for these amendments can be found in the specification at, for example, page 10, lines 5-10. Applicants have cancelled claims 2, 8, 14, 26, 46-49, 51-52, and 57-58. In view of the following remarks, Applicants respectfully traverse the rejections of claims 1-4, 6-10, 12-16, 18-22, 25-28, 30-33, and 36-70 under 35 U.S.C. §§ 102(e) and 103(a).

Rejections under 35 U.S.C. § 102(e)**Claims 1, 7 and 50**

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

Claims 1, 7 and 50, as amended, each recite a combination including at least, "capturing the first network information related to the current session" and "using the captured first network information in another request." Kikinis, taken alone or in combination, fails to teach at least these elements. In the previous Office Action, at

page 5 and 6, the Examiner points to Kikinis, col. 7, lines 12-24, as teaching "capture information related to the current session," and "using the captured information in another request." Here, Kikinis teaches an ID match process, wherein when a hand-held unit connects to the "Proxy-Server," the ID of the hand-held is recognized by the "Proxy-Server," such that information commensurate with the hand-held unit's capabilities can be transmitted to the device. Kikinis, col. 7, lines 12-24. This basically allows the "Proxy-Server" to format the content of a requested web page such that it will be able to be properly displayed on the hand-held.

Also in the previous Office Action, at pages 3 and 5, the Examiner asserts that the "first network information" of Kikinis is the webpage retrieved from the internet. Thus, the "first network information" of Kikinis is different than the ID of the hand-held, which the Examiner alleges is captured. Therefore, nothing in Kikinis, whether taken alone or in combination, constitutes a teaching of a combination including at least, "capturing the first network information related to the current session" and "using the captured first network information in another request." Since the reference does not teach each and every element of the claims, Kikinis cannot anticipate claims 1, 7 and 50. Thus the rejection of claims 1, 7 and 50 under 35 U.S.C. § 102(e) should be withdrawn and the claims allowed.

Moreover, claims 3-4 and 6, 9-10 and 12, and 53-55 respectively depend from claims 1, 7 and 50, and therefore require all of the elements of respective claims 1, 7 and 50. That is, claims 3-4 and 6, 9-10 and 12, and 53-55 recite a combination including at least, "capturing the first network information related to the current session" and "using the captured first network information in another request." Since, as

discussed above, Kikinis, whether taken alone or in combination, fails to teach or suggest a combination including at least, "capturing the first network information related to the current session" and "using the captured first network information in another request," the rejection of claims 3-4 and 6, 9-10 and 12, and 53-55 under 35 U.S.C. § 102(e) should be withdrawn and the claims allowed.

Claims 13, 25, 36, 41, 56, and 66

Claims 13, 25, 36, 41, 56, and 66 each recite a combination including, at least, "capturing information related to the current session" and "using the captured information in another request from another ... device." Kikinis, whether taken alone or in combination, fails to teach at least these limitations. As discussed above, Kikinis stores the ID and capabilities of a hand held device on a "Proxy-Server," recognizes the ID of the hand-held device when it is used again, and then formats information transmitted to the hand-held device such that they correlate to the capabilities of *that device*.

Kikinis merely teaches the capture of the ID and capabilities of a device, such that those capabilities can be used in the format of information the next time the *same device* requests information. Thus, nothing in Kikinis, whether taken alone or in combination, constitutes a teaching or suggestion of, "capturing information related to the current session" and "using the captured information in another request from another ... device," as recited in claims 13, 25, 36, 41, 56, and 66. Since the reference does not teach each and every element of the claims, Kikinis cannot anticipate claims 13, 25, 36, 41, 56, and 66. Thus, the rejection of claims 13, 25, 36, 41, 56, and 66 under 35 U.S.C. § 102(e) should be withdrawn and the claims allowed.

Moreover, claims 15-16 and 18-22, 27-33, 37-40, 42-45, 59-65, and 67-69 respectively depend from claims 13, 25, 36, 41, 56, and 66, and therefore require all of the elements of respective claims 13, 25, 36, 41, 56, and 66. That is, claims 15-16 and 18-22, 27-33, 37-40, 42-45, 59-65, and 67-69 require at least, "capturing information related to the current session" and "using the captured information in another request from another ... device." As discussed above, Kikinis, whether taken alone or in combination, fails to teach or suggest a combination including at least, "capturing information related to the current session" and "using the captured information in another request from another ... device." Thus the rejection of claims 15-16 and 18-22, 27-33, 37-40, 42-45, 59-65, and 67-69 under 35 U.S.C. § 102(e) should be withdrawn and the claims allowed.

Rejections under 35 U.S.C. § 103(a)

Claim 70 was rejected under 35 U.S.C. § 103(a) as being obvious over Kikinis. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., 2001.

Claim 70 depends on claim 66, and therefore requires all of the elements of claim 66. As discussed above, Kikinis, when taken alone or in combination, fails to teach at least, "capturing information related to the current session" and "using the captured information in another request from another ... device," as required by claim 66. Since the references, whether taken alone or in combination, fail to teach or suggest each and every element of the claimed invention, a *prima facie* case has not been made. Therefore the rejection of claim 70 under 35 U.S.C. § 103(a) should be withdrawn and the claim allowed.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-4, 6-7, 9-10, 12-13, 15-16, 18-22, 25, 27-33, 36-45, 50, 53-56, and 59-70 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 7, 13, 25, 36, 41, 50, 56 and 66 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

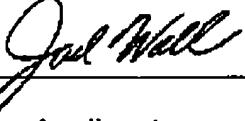
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

Respectfully submitted,

Date: November 11, 2004

By: _____


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